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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,828	04/15/2004	Bianca A. Thomae	07039-454001	8652

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EXAMINER

WALICKA, MALGORZATA A

ART UNIT PAPER NUMBER

1652

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,828

Applicant(s)

THOMAE ET AL.

Examiner

Malgorzata A. Walicka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 19 all in part, and claims 7, 9, 11, 13, 14 in their entirety, drawn to a nucleic acid encoding human arsenic methylase of SEQ ID NO: 5 and its allelic forms, classified in class 536, subclass 23.2.
- II. Claims 15-17, drawn to human arsenic methylase, classified in class 435, subclass 193.
- III. Claims 1, 2 and 19 all in part, and claims 3 in its entirety, drawn to a nucleic sequences upstream of the start codon of SEQ ID NO: 1, which is a genomic DNA of human arsenic methylase, classified in class 536, subclass 24.1.
- IV. Claims 1, 2 and 19 all in part, and claims 4, 5, 6, 8, 10, 12 in its entirety, drawn to nucleic acids molecules at least of ten nucleotides in length wherein said nucleic sequences are variants of SEQ ID NO: 1, having changes in introns 2, 3, 4, 8, 9, and 10 of SEQ ID NO: 1, i.e., 3370, 3398, and 3435, classified in class 536, subclass 24.31/24.33.
- V. Claim 18 directed to three genera of probes having at least 99% sequence identity to nucleotides 550-650, 900-950 and 951-100 of SEQ ID NO:3,

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wherein position 594 is a thymine, position 937 is a cytosine and position 994 is a thymine, classified in class 536, subclass 24.31.

The inventions are independent or distinct, each from the other because:

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions I-V are products that all have different chemical structures and functions or use.

Products of Group I are allelic variants of human genomic DNA encoding arsenic methylase that that are not disclosed as capable of using together with any of products of group II-V.

Group II is directed to the products that are allelic variants of the protein having activity of arsenic methylase and these products are not disclosed as capable of use together with any of products of Groups I and III-V. Products of Group III are upstream regulatory sequences of the gene of SEQ ID NO: 1 and these sequences are not disclosed as capable of use together with any of products of Groups I-II and IV-V.

Products of Group IV are primers and probes used to identify allelic variants of introns of the gene of SEQ ID NO:1. These products are not disclosed as suitable of use together with products of any of Groups I, II, III and V.

Finally products of Group V are probes for the identifying the cDNA of human

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arsenic methylase and variants of said cDNA. These products are not disclosed as capable of use with products of Groups I-IV.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, and furthermore require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka whose telephone number is (571) 272-0944. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Malgorzata A. Walicka, Ph.D.

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Patent Examiner


TEKCHAND SAIDHA
PRIMARY EXAMINER